

REMARKS

Reconsideration of this application in light of the present amendment and remarks is respectfully requested.

Claims 1-20 have been rejected.

Claims 1-20 have been amended.

Claims 1-20 are pending in this application.

Claims 1-20 have been rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of the prior US Pat. 6,735,435. Applicants respectfully request that this rejection be held in abeyance until allowable subject matter is determined. At that time, and if appropriate, a terminal disclaimer may be filed.

Claims 1-6, 11-15 and 20 have been rejected under 35 U.S.C. §102(e) as being anticipated by Paulauskas et al. (US 6,401,033). This rejection is respectfully traversed.

Independent claim 1 has been amended to reflect that a game is provided to a user as part of a sponsor attempt to gain revenue. Support for this can be found in the specification on page 4, lines 1-3. As part of the game the sponsor, defines desired locations that the sponsor wishes the user visit and undesired locations that the sponsor does not want the user to visit. Support for this can be found in the specification on page 4, lines 1-3. Positive points are awarded for desired locations, and negative points are deducted for undesired locations. Support for this can be found in the specification on page 3 lines 5-12, page 7 line 25, and page 13 lines 23-26. Incentives are awarded in accordance with points scored. Support for this can be found in the specification on page 3 lines 13-15. The combination of recitations in claim 1 are not disclosed or suggested in any of the cited references.

Advantageously, applicants' invention of claim 1 provides an entertaining way for sponsors to increase revenue.

Paulauskas et al disclose a single player navigation game. Paulauskas et al does not suggest or disclose: sponsors, sponsor locations, undesired locations, negative points, and sponsor-related incentives. Therefore, Paulauskas et al is missing several elements of applicants' invention.

Independent claims 11 and 20 have also been amended as detailed with respect to claim 1 above, and therefore claims 1, 11 and 20 are all deemed allowable for the same reasons.

Dependent claims 2 and 12 have been recast to reflect that the game can be played by multiple vehicles. Support for this can be found on page 3 line 9.

Dependent claims 3 and 13 have been recast to reflect that awards can be discounts relating to a sponsor's products or services. Support for this can be found on page 3 lines 13-15.

Dependent claims 4 and 14 have been recast to reflect that the game ends at a sponsor location. Support for this can be found on page 10 lines 5-6.

Dependent claims 5 and 15 have been recast to reflect that the game can vary the incentive by setting a prize mode. Support for this can be found on page 12 lines 7-8.

Dependent claims 6 and 16 have been recast to reflect that points are bankable. Support for this can be found on page 12 lines 16-17.

Dependent claims 7 and 17 have been recast to reflect that revealing a challenge for a next location in the game relates to solving the challenge for the current location of the game. Support for this can be found on page 12 lines 16-17.

Dependent claims 8 and 18 have been recast to reflect multiple sponsor can be involved in the game with different points for each. Support for this can be found on page 4 lines 1-4.

Dependent claims 9 and 19 have been recast to reflect that multiple players can also input locations. Support for this can be found on page 7 lines 19-20.

Dependent claim 10 has been recast to reflect that awards have time limits. Support for this can be found on page 9 lines 16-20.

Moreover, claims 2-10 and 12-19 are dependent on claims 1 and 11, respectively, and the above comments with respect to these independent claims are hereby incorporated by reference.

Accordingly, applicants respectfully request that this rejection be withdrawn.

Claims 7-10 and 16-19 have been rejected under 35 U.S.C. §103(a) as being anticipated by Paulauskas et al. This rejection is respectfully traversed.

Claims 7-10 and 16-19 are dependent on claims 1 and 11, respectively, and the above comments with respect to these independent claims are hereby incorporated by reference.

Therefore, claims 7-10 and 16-19 are deemed allowable for the same reasons.

Moreover, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 985 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970). In this case, all the claim limitations are not taught or suggested by the prior art, as explained by the Examiner. Thus, the Paulauskas reference clearly fails to render obvious the claims.

Moreover, a proposed modification or combination of prior art cannot be made if the prior art does not suggest the desirability of the claimed invention. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). As mentioned above and reflected in the Applicants' specification, it is a substantial revenue benefit to deduct points, whereas there is no benefit to

deduct points in a strictly user entertainment system as recited in the amended claims. Paulauskas, for the reasons mentioned above, simply does not suggest the desirability of the deducting points.

It is respectfully submitted that the type of hindsight guessing on how something could have worked is insufficient for purposes of 35 U.S.C. 103(a). The Applicants' specification specifically teaches how sponsors can use a game to obtain revenue, which is different from playing a game for entertainment purposes. Deficiencies of the cited references (Paulauskas) cannot be remedied by the conclusions about what is well known or what one skilled in the art could have done. *In re Zurko*, 258 F.3d 1379, 1385-1386 (Fed. Cir. 2001) (Assessment of basic knowledge and common sense in the art must be based on evidence in the record and cannot be based on unsupported assessment of the prior art).

Accordingly, applicants respectfully submit that this rejection has been overcome, and asks the withdrawal of this rejection.

The other references of record have been reviewed and applicant's invention is deemed patentably distinct and nonobvious over each taken alone or in combination.

For the foregoing reasons, applicants respectfully request that the above rejections be withdrawn.

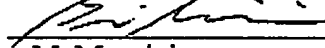
Inasmuch as this amendment distinguishes all of the applicants' claims over the prior art references, for the many reasons indicated above, passing of this case is now believed to be in order. A Notice of Allowance is earnestly solicited.

No amendment made was related to the statutory requirements of patentability unless expressly stated herein. No amendment made was for the purpose of narrowing the scope of any claim, unless applicant has argued herein that such amendment was made to distinguish over a particular reference or combination of references.

Authorization is hereby given to charge any fees necessitated by actions taken herein to Deposit Account 50-2117.

Respectfully submitted,
Newell et al.

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